

REMARKS

The present application relates to inbred maize plant and seed PH6ME. Claims 1-30 are pending in the present application. Claims 2, 19-22, 25-28 and 30 have been amended. Claim 16 has been canceled. No new matter has been added by way of amendment. Applicants respectfully request consideration of the claims in view of the following remarks.

Detailed Action

Applicants have amended the specification to include the U.S. Patent No. of the parent application on page 1, lines 9-10. No new matter has been added.

Applicants further acknowledge that a proper form 1449 Information Disclosure Statement (IDS) is being submitted herein as requested by the Examiner.

Claim Objections

Claims 19-22 are rejected under 37 C.F.R. § 1.75(c), as being improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner states that "[t]he claimed plants do not have all the characteristics of the plant of claim 11; thus, the claims do not properly depend from the parent claim."

Applicants respectfully traverse this objection. Applicants state that claims 19-22 are in proper dependent form as taught in MPEP § 608.01(n) and 37 C.F.R. § 1.75(c). Further, Applicants assert that under 37 C.F.R. § 1.75(c) it is clear that "claims in dependent form shall be construed to include all limitations of the claim incorporated by reference into the dependent claim". Claims 19-22 include the plant of claim 11 wherein the plant is "[a] maize plant having all the physiological and morphological characteristics of inbred line PH6ME, wherein a sample of the seed of inbred line PH6ME was deposited under ATCC Accession Number PTA-4529". In addition, claims 19-22 claim the maize plant of claim 11 with additional limitations, which are not necessarily present in the maize plant of claim 11. The presence of these additional limitations does not mean that claims 19-22 do not possess all limitations of claim 11; these claims still require a maize plant having the physiological and morphological characteristics of inbred line PH6ME. Furthermore, Applicants respectfully asserts that Applicants are aware that

in view of a meeting with the Group Director in July 2006, the Examiner's were informed that the present claim set, including claims 19-22, were in proper form and would be allowable as has been evidenced in analogous Pioneer Hi-Bred Int'l, Inc. inbred continuation cases. Therefore, Applicants assert that the claims are consistent with allowable claims and respectfully request this objection be alleviated.

Rejections Under 35 U.S.C. § 112, First Paragraph

A. Written description regarding Claim 16

Claim 16 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner states "the claim is drawn to a maize seed produced by growing a hybrid maize plant and collecting the seed. This seed therefore does not have a haploid copy of the same genome as the parent plant of claim 11." See Office Action, pp. 2-3.

Although not acceding to the Examiner's rejection, in an effort to expedite prosecution and reduce the issues upon appeal, Applicants have now canceled claim 16, thereby alleviating this rejection.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 28-29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. See Office Action, pp. 2-3.

The Examiner states that claims 28 and 29 are indefinite because "[t]he method claim 'employing the maize plant' in claim 28 does not recite clearly defined positive method steps. The improper Markush group 'using one or more plant breeding techniques selecting from the group consisting of . . .' renders claim 29 indefinite, since it is unclear how many techniques would be used and in what combinations." See Office Action, p. 3.

Applicants respectfully traverse this rejection. Although not acceding to the Examiner's rejection, in an effort to expedite prosecution, Applicants have amended claim 28 to state "A method for developing a second maize plant in a maize plant breeding program comprising

applying plant breeding techniques to a first maize plant, or parts thereof, wherein said first maize plant is the maize plant of claim 11 and wherein application of said techniques results in development of said second maize plant.” Further, Applicants have obtained allowance from the Supervisory Patent Examiner, Anne Marie Grunberg, regarding claims 28-29 as has been evidenced in analogous allowed and issued Pioneer Hi-Bred Int’l, Inc. inbred continuation cases. Moreover, Applicants are aware that in view of a meeting with the Group Director in July 2006, the Examiner’s were informed that the present claim set, including claims 32-33, was in proper form and would be allowable as has been evidenced in analogous allowed and issued Pioneer Hi-Bred Int’l, Inc. inbred continuation cases. Applicants respectfully request this rejection be alleviated in light of the above statements.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. §§ 102(b)/103(a)

Claim 16 is rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Hoffbeck (U.S. Patent No. 5,723,723). The Examiner states that “it appears that the claimed seeds are the same as the prior art maize cultivars . . . [a]lternatively, if the claimed seeds of the instant invention are not identical . . . then it appears that . . . only differ from the claimed seeds due to minor morphological variation”. See Office Action, pp. 4-5.

Although not acceding to the Examiner’s rejection, in an effort to expedite prosecution, claim 16 has been canceled, thus alleviating this rejection. Applicants respectfully request the Examiner withdraw the rejections to claim 16 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) as obvious over Hoffbeck (U.S. Patent No. 5,723,723).

Double Patenting

The Examiner rejects claims 1-30 under the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending U.S. Patent No. 6,759,578. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other. See Office Action, pp. 5-6.

Applicants are herein submitting a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c), which disclaims any term of a patent issuing from this application which would extend beyond the term of copending U.S. Patent No. 6,759,578.

Therefore, Applicants submit that the claims are in proper form for allowance and respectfully request reconsideration and withdrawal of the nonstatutory obviousness-type double patenting rejections.

Conclusion

In conclusion, Applicants submit in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any fees inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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